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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,091

08/21/2006

Harald Hoepfner

82577

4155

23685

7590

07/07/2009

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EXAMINER

WILLIAMS, JAMILA O

ART UNIT

PAPER NUMBER

3725

MAIL DATE

DELIVERY MODE

07/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/590,091

Applicant(s)

HOEPPNER ET AL.

Examiner

JAMILA WILLIAMS

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

For example the claims do not include a proper transitional phrase thereby making the scope unclear. See MPEP 2111.03.

Claim 1 recites the limitation "the laminated layers" in line 6 and 7. There is insufficient antecedent basis for this limitation in the claim.

Throughout the claims the use of the punctuation mark "-" is unclear. This does not appear to follow what is known in U.S. practice. Additionally, it is not clear if the limitations between these punctuation marks are positively recited in the claims.

In claim 14, it is unclear what is encompassed by the phrase "especially of PVC ABS, PET-G, PET, PE, PP, PA, teslin, PC or of sandwich-type film combinations especially of the aforementioned materials". It is not clear how this phrase further limits the claim as presently presented.

In claim 12, "a laminated layer sheath" is recited, it is not clear if this is the same sheath recited in claim 1 or if this is a different structure.

Regarding claims 3 and 12, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-2,4-5,9-11,13-14,18,21-25 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 03/100721 to Trantoul et al (hereinafter Trantoul).

Note: the rejection of the claims is being based on the WO Publication due to the publication date thereof being before the priority claimed by applicant. All references to the WO document will be made using the U.S. equivalent Patent No. 7,360,712 since this document is in English.

Regarding claim 1, Trantoul discloses a method of production of a security document with at least one security cambric (page 25) and at least one transponder unit (7) characterized in that at least one laminated layer (3,30) is applied on one side of the security cambric and transponder (figure 5), the security cambric (25) and transponder

(7) are fully encompassed by the laminated layers and a circumferential, closed edge is provided by the laminated layers and a sheath is formed (column 12 lines 10-15).

Regarding claim 2, Trantoul discloses the sheath is introduced into a book block (figure 7).

Regarding claim 4, Trantoul discloses the security cambric and transponder unit are a composite formed by several layers (figure 5).

Regarding claim 5, Trantoul discloses the transponder unit is applied on the security cambric and a composite is formed which is encompassed by the laminated layers (figure 5).

Regarding claim 9, Trantoul discloses the laminated layers are glued (column 12 lines 10-15).

Regarding claims 10-11, Trantoul discloses the transponder unit is personalized after the production of the laminated layer sheath with an algorithm (column 7 lines 64-67 and column 8 lines 1-5).

Regarding claim 13, Trantoul discloses providing information to the transponder unit after laminating the document, (column 7 lines 58-67- any information provided thereon can be considered a security characteristic).

Regarding claim 14, Trantoul discloses the laminating layers are produced by plastic films (column 9 lines 17-19).

Regarding claim 18, Trantoul discloses the transponder unit comprises a chip module for contacting an external coil or antenna, with the coil or antenna being

produced through screen printing by an inkjet technique with a conductive ink (column 10 lines 1-7).

Regarding claim 21, Trantoul discloses the laminated layer is processed as a transparent film for the production of the sheath (column 9 lines 15-17 and column 12 lines 10-15).

Regarding claim 22, Trantoul discloses a book type security document (passport) with at least one security cambric (page 25) and a transponder unit (7) encompassed by at least one laminated layer (3,30) and a laminating sheath is formed (column 12 lines 10-15).

Regarding claim 23, Trantoul discloses the security cambric and transponder unit are each designed smaller than a page of a book block (figure 7).

Regarding claim 24, Trantoul discloses the security cambric is designed as an inside or personalization page for a book block (column 11 lines 8-14).

Regarding claim 25, Trantoul discloses the laminated layer is designed as a cover or overlay film (figure 3 and column 12 lines 10-15).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trantoul.

Regarding claim 3, Trantoul discloses encompassing the security cambric and transponder unit by the laminating layer. However Trantoul does not disclose stamping or cutting the laminated edges. It is well known in manufacturing however to cut or trim the edges to a desired size. It would have been obvious to one having ordinary skill in the art at the time the invention was made to cut the edges for the purpose of providing proper sizing or for the purpose of providing a cleaner edge. This known technique is recognized as part of the ordinary capabilities of one skilled in the art.

Regarding claims 15-17 and 19, Trantoul discloses the transponder unit having a chip and antenna (housed with chip and unhoused). Trantoul does not however disclose the use of tape automatic bonding for bonding the transponder to the substrate or flip chip technology for contacting the chip and antenna, fastening chip module by means of a casing compound. However in that both of these are well known connecting or interconnecting processes in the art, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use these known methods to connect the elements of Trantoul for the purpose of completing the assembly.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trantoul in view of WO 98/19870 to Almgren et al (hereafter Almgren).

Trantoul discloses the elements of the claims but for the projection for sewing laminated sheath into book block.

Almgren teaches having a passport with a laminated sheath (1) having projection (10) sewn into book block (sewing 13, see figure 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the projection of Almgren with the sheath of Trantoul for the purpose of binding the sheath into a book block.

8. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trantoul in view of 5,590,912 to Stevens. Trantoul discloses the elements of the claims but for the laminated sheath forming a double page.

Stevens teaches a laminated sheath assembly that forms a double page in a book block (figure 4-6, sheath 126,127), the double page having a stay or groove (area in the fold of the book block receiving the staple in figure 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the double page teaching of Stevens with the sheath of Trantoul for the purpose of providing additional security documents into the book block.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trantoul in view of 6,135,503 to Lob et al (hereafter Lob). Trantoul discloses the elements of the claims but for the security characteristic provided in the sheath after production thereof.

Lob teaches having a passport with a laminated sheath having laser formed security characteristics in the form of microrelief (column 4 lines 15-28). It would have been

obvious to one having ordinary skill in the art at the time the invention was made to use the laser inscribed characteristic of Lob with the sheath of Trantoul for the purpose of providing additional security to the document.

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trantoul in view of 5,528,222 to Moskowitz et al (hereinafter Moskowitz).

Trantoul discloses the elements of the claims but for having a thinned or punched area in the cambric or sheet for the chip module.

Moskowitz teaches having chip module for use in passports wherein there is a recess in the substrate for insertion of the chip module (column 5 lines 8-20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the recess as taught by Moskowitz with the substrate of Trantoul for the purpose of reducing the thickness of the assembly.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMILA WILLIAMS whose telephone number is (571)272-4431. The examiner can normally be reached on Monday-Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on 571-272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. W./
Examiner, Art Unit 3725

/Dana Ross/
Supervisory Patent Examiner, Art
Unit 3725